

REMARKS

In the Office Action mailed May 6, 2003 (Paper No. 28), the Examiner rejected claims 33-48 and again withdrew from consideration claims 49-51. By the present Response, Applicants have canceled claims 33-51 without prejudice and add new claims 52-68. Applicants assert that new claims 52-68 do not present new matter and, as such, these claims are believed to be patentable. In light of the following remarks, Applicants respectfully request allowance of claims 52-68.

No additional fees are believed due. However, if the Examiner determines that additional fees are necessary, then the Examiner is authorized to charge the deposit account listed on the attached transmittal form.

Objection to the Drawings

In the Office Action, the Examiner objected to the drawings. Specifically, the Examiner objected to the fact that the lead line of reference number 66 in Fig. 7 was not dashed, thus failing to indicate the hidden nature of the element to which it refers. Applicants have corrected the drawings as shown in red-ink on the sheet attached hereto. Additionally, Applicants also provide a black-line drawing, attached hereto, incorporating the amendments to the drawings. Accordingly, Applicants respectfully request that the Examiner withdraw the objection.

Rejections Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 33, 36-38, 43 and 44 under 35 U.S.C. § 102 (b) as being anticipated by the Good et al. reference (U.S. Pat. No. 5,571,256). However,

as discussed above, these claims have been canceled without prejudice. Thus, Applicants respectfully assert that a discussion germane to these canceled claims is moot. Nonetheless, in the interest of expediting prosecution, Applicants address the new claims in light of the substance of the Examiner's previous rejection. That is, Applicants respectfully assert that new claims 52-68 are patentable over the Good reference because the Good reference does not disclose all of the features recited by the pending claims.

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). Thus, for a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

Independent Claim 52 and Claims Depending Therefrom

New independent claim 52 recites a telescoping rail assembly at least partially *interposed between* a pair of rack members. In contrast to the instant claim, the Good reference discloses a device in which the telescoping slide structure 44 is positioned *along side* of the vertical support channels 14a and 16a. *See* Good et al., Fig 2. Indeed, Figure 2 of the cited reference clearly demonstrates that in no way is any portion of the telescoping slide structure 44 located at a position *interposed between* the vertical support channels 14a and 16a. Rather, the Good et al. reference, in an antithetical manner, teaches a slide structure 44 that is *juxtaposed* to the support channels. This *juxtaposed* design of Good et al. occupies a larger volume of the interior of the rack cabinet 12, and, as such, reduces the interior space available for the computer component

enclosure. This lack of appreciation for the conservation of interior space is consistent with deficiencies of prior art device as discussed in the background section of the application. *See* Application, page 2, lines 13-20. Indeed, viewing the teachings of Good et al. in light of the application's background only buttresses Applicants' assertion that the *juxtaposed* design taught by Good et al. does not anticipate the *interposed* telescoping rails as recited in the instant claim. Thus, it is clear that the Good reference does not disclose or suggest the above-listed recited features.

Because the Good reference does not disclose all of the features recited by the instant claim, Applicants respectfully assert that independent claim 52 is patentable and in condition for allowance. Moreover, Applicants respectfully assert that new dependent claims 53-56 are also patentable not only by virtue of their dependence to an allowable base claim, but also for the additional features recited therein. Allowance is respectfully requested.

Independent Claim 57 and Claims Depending Therefrom

New independent claim 57 recites first and second telescoping rail assemblies that are at least partially *interposed* between the respective first or second pair of rack members. As discussed above, the Good reference does not disclose these features. Rather, Good et al. teach a telescoping rail assembly that is wholly *juxtaposed* to the vertical channel members. Clearly, an element *juxtaposed* to a pair of second elements cannot also be *interposed* between the same second elements.

Accordingly, Applicants respectfully assert the new independent claim 57 is patentable over the Good reference. Additionally, Applicants respectfully assert the dependent claims 57-62 are also patentable over the Good reference because of their dependence on an allowable base claim as well as by virtue of the additional features recited therein. In light of the foregoing remarks, allowance is respectfully requested.

Independent Claim 63 and the claims Depending Therefrom

New independent claim 63 recites first and second telescoping rail assemblies that are at least partially *interposed* between the respective first or second pair of rack members. As discussed above, the Good reference does not disclose these features. Rather, the Good reference discloses rail assemblies that are *juxtaposed* to the vertical channel members. Again, an element that is *juxtaposed* to a feature is antithetically oriented when compared to an element that is *interposed* between the feature.

Accordingly, Applicants respectfully assert the new independent claim 63 is patentable over the cited reference. Additionally, Applicants respectfully assert the dependent claims 64-68 are also patentable over the cited reference because of their dependence on an allowable base claim as well as by virtue of the additional features recited therein. In light of the foregoing remarks, reconsideration and allowance are respectfully requested.

First Rejection Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected dependent claims 34, 35, 39, 45 and 46 under 35 U.S.C. § 103(a) as being unpatentable over the Good et al. reference in view of the Fall

reference (U.S. Pat. No. 3,712,690). However, as stated above, these claims have been canceled without prejudice. Nonetheless, in the interest of expediting prosecution, Applicants address the substantive matter of the Examiner's rejection as applied to the pending claims. In short, the Fall reference does not obviate the deficiencies of the Good reference as discussed above.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

However, the Examiner, in response to Applicants' prior remarks, stated that "it should be noted that [a lack of] obviousness cannot be established by attacking references individually when a rejection is based on a combination of references." Paper No. 28, page 6. The Examiner further stated, "there is no requirement for a secondary reference to meet every limitation of the claim before it can be utilized." *Id.* Applicants do not necessarily agree with the Examiner's statements.

Although an obviousness rejection may be based on a combination of references, the combination, as a whole, must still disclose each of the features recited in a claim. Thus, if each

of the individual references fails to disclose a recited feature, then the obviousness rejection must also fail. In the instant case, neither reference discloses a telescoping rail or a support member recess that is *interposed* between vertical rack members. Indeed, the Good reference discloses a telescoping structure *juxtaposed* to vertical channels and the Fall '690 reference merely discloses a telescoping structure independent of any vertical members. Neither of the references discloses relevant features that are *interposed* between the vertical members. Thus, Applicants reiterate that the cited references, taken alone or in combination, fail to disclose all of the recited features of the instant claims.

Therefore, Applicants respectfully assert that claims 52-68 are patentable and in condition for allowance. Allowance is respectfully requested.

Second Rejection Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected dependent claims 40-42, 47 and 48 under 35 U.S.C. § 103(a) as being unpatentable over the Good reference in view of the Fall '690 reference and in further view of the Fall et al. reference (U.S. Pat. No. 3,681,505). However, as stated above, these claims have been canceled without prejudice. Nonetheless, in the interest of expediting prosecution, Applicants address the substantive matter of the Examiner's rejection as applied to the pending claims. In short, Applicants respectfully assert that the two Fall references (Fall '690 and Fall '505) do not obviate the deficiencies of the Good reference as discussed above.

Again, the Fall '690 reference merely discloses a slide structure independent of any rack, and, as such, could not disclose the recited features of the independent claims discussed above.

Moreover, the Fall '505 reference also merely discloses a slide rail independent of any rack structure, and, as such, also does not disclose the recited features of the independent claims discussed above. Indeed, neither of the Fall references nor the Good reference, taken alone or in combination, teaches a telescoping rail that is *interposed* between a pair of rack structures.

Accordingly, Applicants respectfully assert that new claims 52-70 are patentable over the cited references, taken alone or in combination. Allowance is respectfully requested.

Conclusion

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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